The claims of the application have been rejected as unpatentable over U.S. Patent No. 5,193,815 in view of U.S. Patent No. 4,756,533. Claim 1 has been rejected on the ground the claim describes a conventional scratch and win ticket and that the invention would have been obvious from the '815 Patent and that the claimed printed matter is not functionally related to the substrate as required in In re Gulack. The rejection is hereby traversed and reconsideration is respectfully requested.

It is respectfully submitted that In re Gulack has been misapplied as it pertains to the present invention and how that invention relates to the '815 Patent reference. Structurally, the Gulack invention is composed of a band and a plurality of individual digits imprinted on the band at regularly spaced intervals. The Examiner of the Gulack application rejected all claims under Section 101 (non-statutory subject matter) and over Wittcoff under Section 103. The Section 101 rejection was dismissed out of hand and the CAFC focused on the Section 103 rejection.

The Examiner's position was that the appealed claims differed from Wittcoff only with respect to the specific digits printed on the band. The Examiner found no relationship between the digits and the band except that the band is the surface on which the digits are printed. The rejection was sustained by the Board of Appeals because the endless loop formed by the hat band with numerical digits printed thereon (as disclosed in Wittcoff) is the same structure claimed by Appellant and the sole difference is in the content of the printed material.

The CAFC overruled the Board of Appeals. The CAFC stated that differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. In particular, the CAFC stated that the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.

The CAFC found that the digits of Gulack's invention were functionally related to the band and because Wittcoff failed to disclose or suggest the subject matter recited in the claims on appeal, the rejection was reversed.

The CAFC also addressed the issue of what is meant by "functional relationship".

> "What is required is the existence of differences between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate." (Page 404)

It was found that Wittcoff disclosed the application of printed matter to a band and the band was present for purposes of support and display. The Gulack invention also applied printed matter to a band. What was different about Gulack was that he required a particular sequence of digits to be displayed on the outside surface of the band. These digits are related to the band in two ways (1) the band supports the digits; and (2) there is an endless sequence of digits. In concluding that Gulack was patentable over Wittcoff, the CAFC stated that the differences between the appealed claims and Wittcoff reside in Appellants particular sequence of digits, and in the derivation of that sequence of digits. These features are critical to the invention disclosed by the appealed claims.

The application of In re Gulack to the present invention makes it clear that the present invention is patentable over the '815 Patent. The present invention has the following essential features. There is a first play area comprising a plurality of first jig-saw type puzzle pieces. These pieces are covered by a removable scratch-off layer. There is a second play area comprising at least one second play region with each second play region containing at least two second jig-saw type puzzle pieces which may be the same shape as one or more of the first jig-saw type puzzle pieces. Of particular importance to the claimed invention is a jig-saw type puzzle piece identification system comprising identification means appearing on corresponding first and second jig-saw type puzzle pieces for identifying if there is a match between such puzzle pieces.

Therefore, the present claims require a jig-saw type puzzle piece identification system which is displayed on the first and second jig-saw type puzzle pieces which, of course, appear on the lottery ticket. Each identifier is, of course, used to provide a unique match between first and second jig-saw type puzzle pieces. Thus, the present invention provides a structural relationship between the printed matter and the substrate in essentially the same way as the CAFC held that Gulack does.

Given that there is a functional relationship between the printed matter and the substrate, it becomes clear that the present invention is neither taught nor suggested by the '815 Patent.

The '815 Patent discloses an instant bingo game which includes a single caller's card and a plurality of player's cards. Like the conventional bingo game, the reference provides for the random selection of a bingo number from the caller's card. This number includes a letter (e.g. "B") and an alphanumeric number (e.g. "03"). If this bingo number appears on the player's card, then the space occupied by that number is awarded to the player. It is important to note that the matching of the bingo number from the calling card with the player's card is the object of the '815 Patent lottery game. There is no separate identification system being employed in the '815 Patent instant bingo game.

In the present invention, there are two play areas each containing a series of jig-saw type puzzle pieces. If the present invention were the same or similar to the '815 Patent, there would be no identification system as required in the present claims. If the '815 Patent system were applied to the present invention (see Figures 1 and 2) the individual puzzle pieces from the left hand side of the puzzle would be uncovered. The player would then try to visually ascertain if the uncovered puzzle pieces could then be matched on the right hand side of the lottery ticket. However, this lottery game would not function well because of the difficulty of visually matching pieces having an irregular shape. In the '815 bingo system, there is no such difficulty because the average player has no difficulty in matching "B03" in the caller's card with "B03" on the player's card. In a game employing jig-saw type puzzle pieces, this system would not work.

Accordingly, Applicants have devised a jig-saw type puzzle piece identification system providing a visual enhancement to enable the average player to effectively match pieces and determine if the lottery ticket is a winning or losing ticket. The '815 Patent simply does not disclose any such jig-saw type puzzle piece identification system as that term is employed in the present claims.

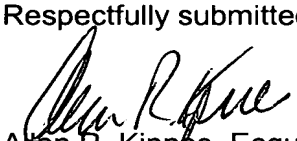
The citation of Hopkins does not cure the deficiencies of the primary reference. Hopkins represents the conventional lottery ticket employing jig-saw type puzzle pieces. The only way a player can effectively match their regular shaped pieces is by physically lifting the puzzle piece from one part of the puzzle and

matching the same with an outline of the same puzzle piece on another portion of the lottery ticket. While this system enables players to make the matches and determine if a prize has been won, it is a cumbersome system often resulting in the puzzle pieces being lost or falling off the lottery ticket. Applicants' invention has addressed this problem by employing a jig-saw type puzzle piece identification system which now makes it possible to avoid lifting the jig-saw type puzzle piece off one portion of the lottery ticket and placing it on another portion of the lottery ticket.

In view of the foregoing, Applicants submit that the present application is in condition for allowance and early passage to issue is therefore deemed proper and is respectfully requested.

It is believed that no fee is due in connection with this matter. However, if any fee is due, it should be charged to Deposit Account No. 23-0510.

Respectfully submitted,



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